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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KEYES, IV et al.

Serial No.: 09/934,036

Title: SHARED-USE DATA
PROCESSING FOR PROCESS CONTROL
SYSTEMS

Filed: August 21, 2001

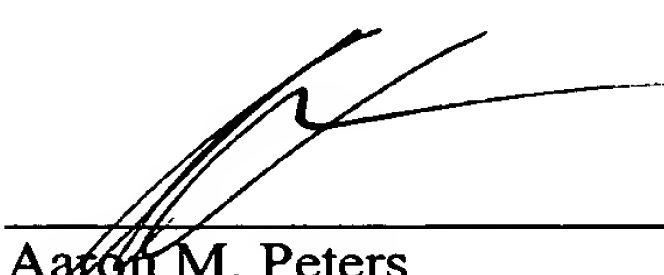
Group Art Unit: 3643

Examiner: Ailes, Benjamin A.

Atty. Docket Number: 30203/37509

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RESPONSE TO OFFICE ACTION DATED AUGUST 12, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

In response to the restriction requirement raised in the Office action dated August 12, 2005, the applicants hereby provisionally elects, *with traverse*, the claims associated with Group I as identified in the Office action, namely claims 1-23 and 35-39 for further prosecution in this application.

The applicants respectfully submits that the Examiner has not made a *prima facie* showing that each of the groups identified in the Office action relate to a patentably distinct invention. According to MPEP 803, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. ... There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent (see MPEP 802.01, 806.04, 808.01) or distinct as claimed (see MPEP 806.05 – 806.05(i)); and (B) There must be a serious burden on the examiner if restriction is required (see MPEP 803.02, 806.04(a) - 806.04(i), 808.01(a), and 808.02). ... For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the

examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.”

Contrary to the requirements above, there does not exist a serious burden on the Examiner for a search and examination of the entire application without the restriction. Further, the Examiner has not satisfied the necessary criteria for a restriction of claims, as required by MPEP 803, because the identified groups have been improperly identified according to combination and subcombination. As a result, there is no separate burden on the examiner because a search for Group I must be performed in order to perform a search for Group II, and because Groups I and II do not include separate utility.

Contrary to the requirements of MPEP 803, there is no serious burden on the Examiner to conduct a search and examination of the entire application, because the Examiner has already performed a search and examination of the entire application without serious burden. Although the Examiner has noted separate classifications for identified Groups I and II, the Office action dated March 4, 2005 provides evidence rebutting any *prima facie* showing of a serious burden on the Examiner. Enclosed in the Office action was a Notice of References Cited listing ten references as a result of a search conducted by the Examiner in a variety of classifications. Further, the Office action included an examination on the merits of each of claims 1-39. As a result, the Office action shows that a search and examination of the entire application, including all of claims 1-39, was, in fact, conducted by the Examiner without a serious burden. Accordingly, the *prima facie* assertion of a serious burden on the Examiner has been rebutted as provided by MPEP 803, and a search and examination of the entire application must be made, even in the event the claims are directed to independent or distinct inventions, as required by MPEP 803.

Furthermore, the Examiner has improperly identified the combination and subcombination. In particular, MPEP 806.05(a) defines a combination as “an organization of which a subcombination or element is a part.” The applicants respectfully submit that, to the extent that the distinction between combination and subcombination is relevant, claims 1-23 and 35-39 (Group I) are more properly classified as subcombination claims, because claims 1-23 and 35-39 (Group I) particularly recite structure similar to structure used by the method

of claims 24-34 (Group II), and because claims 1-23 and 35-39 (Group I) recite the similar or less structure than the structure used by the methods of claims 24-39 (Group II).

In particular, claims 1-23 and 35-39 (Group I) each recite a data processing system that includes structure similar to at least some of the structure used by the method recited in claims 24-34 (Group II). For example, claims 24-34 each include receiving information from a plurality of process plants via an internet, and claims 1-23 and 35-39 each include a plant, or multiple plants, coupled to an open network, such as an internet. Each of claims 24-34 further includes processing the received information using a cluster of redundant servers to generate analysis results, and claims 1-23 and 35-39 each include a server, or cluster of redundant servers, which uses a data processing application to generate analysis results. Each of claims 24-34 includes storing the analysis results in a plurality of redundant data historians, and each of claims 1-23 and 35-39 includes a data historian, or plurality of redundant data historians. Each of claims 24-34 also includes providing access to the analysis via the internet, and claims 1-23 and 35-39 each include a server, or cluster of redundant servers, where the analysis results are sent via or are accessible via an open network, such as the internet. As a result, claims 1-23 and 35-39 provide particular structural elements that are similar to much of the structure used by the method recited in each of claims 24-34.

Further, each of claims 1-23 and 35-39 (Group I) recite the similar or less structure that that used by the method recited in each of claims 24-34 (Group II). As indicated above, each of claims 24-34 recites receiving data from a plurality of plants, whereas each of claims 1-23 and 35-39 recites either a plant or multiple plants. Each of claims 24-34 use a plurality of redundant data historians, whereas each of claims 1-23 and 35-39 recites either a data historian or plurality of redundant data historians. Each of claims 24-34 use a cluster of redundant servers, whereas each of claims 1-23 and 35-39 recites either a server or a cluster of redundant servers. Each of claims 24-34 use an internet whereas each of claims 1-23 and 35-39 recites an open network such as an internet. As a result, claims 1-23 and 35-39 recite similar or less structure than the structure used by the methods of claims 24-39.

Accordingly, claims 1-23 and 35-39 (Group I) are more properly classified as the subcombination claims because the systems of claims 1-23 and 35-39 (Group I) recite elements that are a used by the method of claims 24-34 (Group II). Further, claims 1-23 and 35-39 (Group I) are more properly classified as the subcombination claims because claims

24-34 (Group II) recite using similar or less structure than the structure recited by claims 1-23 and 35-39 (Group I).¹

The applicants further submit that a separate burden on the examiner cannot exist because a search cannot be performed for the combination claims (Group II) without conducting a search for the subcombination claims (Group I). A proper search for claims 24-34 cannot be conducted without searching for the structure used by claims 24-34. As indicated above, the method recited in each of claims 24-34 (Group II) uses structure similar to that recited in each of claims 1-23 and 35-39 (Group I). As a result, in order to perform a search for a method as recited in claims 24-34, a search must be performed for the system of claims 1-23 and 35-39, because claims 1-23 and 35-39 recite structure similar to that used by the methods of claims 24-34. Accordingly, there cannot exist a separate burden on the examiner, when the subcombination claims (Group I) must be searched in order to perform a search for the combination claims (Group II).

Additionally, Groups I and II do not include separate utility and the examiner has not properly identified separate utility, as required by MPEP 806.05(c). "In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP § 808.02. The inventions are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in other and different relations. When these factors cannot be shown, such inventions are not distinct." Additionally, the restriction requirement is improper under MPEP 806.05(c)(III). "If the applicant proves or provides an argument supported by facts, that the other utility, suggested by the examiner, cannot be accomplished,

¹ The applicants note that although the claims associated with Group I each recite a system having structure similar to the structure used by the method of each of the claims associated with Group II, this should not be construed to require that the structure used by the methods of claims 24-34 must include each limitation of the structure recited by claims 1-23 and 35-39, or that the systems of claims 1-23 and 35-39 must include each limitation of the structure used by the methods of claims 24-34.

the burden shifts to the examiner to document a viable separate utility or withdraw the requirement.”

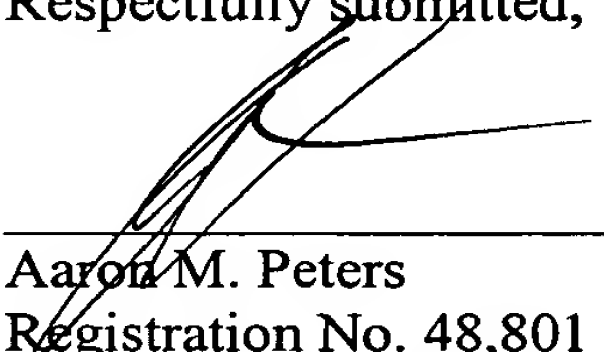
As shown above, the claims of Group II use structure similar to that recited in the claims of Group I. In particular, the method recited in each of claims 24-34 recites receiving information from process plants, processing the information using a cluster of redundant servers, storing analysis results in a plurality of redundant data historians, and providing access to the analysis via an internet. Each of claims 1-23 and 35-39 recites a plant(s), a server(s), and a data historian(s), where analysis results are provided via or accessible via an open network such as an internet. Likewise, each of claims 1-23 and 35-39 recites a system that includes structure that performs functions similar to that recited in claims 24-34. For example, the systems recited in each of claims 1-23 and 35-39 includes structure to receive information from a plant(s), process the information to generate analysis results, and send or provide the analysis results via an open network such as an internet. Accordingly, Groups I and II do not necessarily possess separate utility that requires restriction.

Further, the utility suggested by the examiner, namely cost accounting for goods and services and billing methods thereof, ignores the additional recitations of claims 24-34. For example, each of claims 24-34 further recites receiving information from process plants, processing the information using a cluster of redundant servers, storing analysis results in a plurality of redundant data historians, and providing access to the analysis via an internet. Similar functions are provided by the systems recited in each of claims 1-23 and 35-39, as noted above. Accordingly, claims 1-23 and 35-39 associated with Group I do not have a separate utility that requires restriction from claims 24-34 associated with Group II.

Appl. No. 09/934,036
Resp. dated September 12, 2005
Reply to Office action of August 12, 2005

For these reasons, applicant respectfully submits that the restriction requirement is improper, and that the restriction should be withdrawn. As a result, applicant respectfully requests that each of claims 1-39 presently pending in this application be examined. Should the Examiner have any questions, the Examiner is respectfully invited to telephone the undersigned.

Respectfully submitted,


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